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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,776	01/23/2002	Yehouda Harpaz		8395

33953 7590 12/29/2005

YEHOUDA HARPAZ  
129 CORRIE ROAD  
CAMBRIDGE, CB1 3QQ  
UNITED KINGDOM

EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3713

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/031,776	Applicant(s) HARPAZ, YEHOUDA	
	Examiner Alex P. Rada	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Response to Appeal Brief**

1. In view of the appeal brief filed on October 27, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final), or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on August 12, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 6,568,683 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

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### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

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- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and

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processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The examiner notes that a descriptions of new figure 6 filed September 3, 2003 is missing in the disclosure.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-4 of copending Application No. 10/031890. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 3-4 of the copending Application No. 10/031890 "anticipates" application serial number 10/031,776 of claim 1. Accordingly, the application of claim 1 are/is not patentably distinct from copending Application No. 10/031890 of claims 3-4. Here, copending Application No. 10/031890 of claims 3-4 requires elements a grid of grid points on a flat surface, visible grid points, an illumination source, two colour visible elements, and when a player presses a grid point the board changes the illumination from off\on position to on\off position while the application of claim 1 only requires elements a grid of grid points, illumination of two different colors, and a CPU is notified whenever any of the grid points are pressed and illuminated on a flat surface. Thus it is apparent that the more specific copending Application No. 10/031890 of claims 3-4 encompasses the application of claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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5. Claim 1 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/031,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 4 of the copending Application No. 10/031,942 "anticipates" application serial number 10/031776 of claim 1. Accordingly, the application of claim-1 are/is not patentably distinct from copending Application No. 10,031,942 of claims 1 and 4. Here, copending Application No. 10,031,942 of claims 1 and 4 requires elements a grid of grid points on a flat surface, visible grid points, an illumination source, two colour visible elements, and when a player presses a grid point the board changes the illumination from off\on position to on\off position while the application of claim 1 only requires elements a grid of grid points, illumination of two different colors, and a CPU is notified whenever any of the grid points are pressed and illuminated on a flat surface. Thus it is apparent that the more specific copending Application No. 10/031,942 of claims 1 and 4 encompasses the application of claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



In claim 1, line 21, the phrase of, “if the sum is larger or equal the point is a legal move for the player” is vague and indefinite because what applicant regards the language of “the sum is larger or equal the point” cannot be determined.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golad (US 6,231,441).

10. Golad discloses a grid of grid points on a flat surface (figure 1), where each grid point is a visible element which is capable of detecting when it is pressed (figure 1 and col. 2, lines 43-52), and can be illuminated in two different colors (col. 2, line 35 – col. 3, line 3), allocated to respective players (col. 3, lines 28-43), by an illumination source inside or below the surface (col. 2, line 59 – col. 3, line 7), and a character display col. 2, lines 59-62), and a game manager made of a CPU and memory (within computer 11), connected electronically to the grid points and illumination sources such that it has complete control on which grid point is illuminated and in what colour (figure 1 and col. 3, lines 21-34), and it is notified whenever any of the grid points is pressed (figure 1 and col. 3, lines 21-43), and a computer program which is executed by the CPU (col. 2, lines 17-8), which manages a one or more games (col. 2, lines 17-8) and the game manager declares as winner the player that has more points of their color in the end of the game (col. 4, lines 23-27).

Golad does not expressly disclose at least one game is played according to these rules: when a player touches a point, the games manager checks if it is a legal move, and if it is switches the point to the player's color to evaluate if a point is a legal move, the games manager checks in turn each of a pre-defined set of imaginary straight lines emanating from the point, assigning a value of 0 to each of these lines that does not pass through an illuminated point, a value of 1 if the closest illuminated point that it passes through is illuminated with the colour of the player, and -1 if it is in the opponent's color and then compares the sum of the values of all the lines to a fixed number, and if the sum is larger or equal the point is a legal move for the player as recited in claim 1.

Golad does however teach upon starting of the game, the computer randomly selects which player color goes first and displays the initial playing situation on the games' board. The object of the game of Golad is to occupy as much of the playing area with a particular color by trapping one of the other player color. For example, the playing area of D4 is red, D5 is green, E4 is blue, and E5 is yellow. If the red player is elected to go first, red must occupy another space to block one of the other player colors. If the red player chooses area D3, an error will occur indicating an incorrect move. The player operates the help function and computer illuminates playing areas D6, F4, and F6 in red for moves that can be made. It can be deduced from the example in col. 3, line 44 – col. 4, line 27, that when the help feature is activated, the origin of the current player red in area D4, the computer determines a plurality of correct moves for the red player to choose. In order to block the green player in area D5, option one for red will be area D6. In order to block the yellow player in area E5, option two for red would be F6. In order to block the blue player in area E4, option three for red will be area F4. As the computer determines all of the correct possible moves for a particular player it can be deduced by the example in col. 3, line 44 – col. 4, line 27 provides an equivalent to applicant's game manager checking in turn each of a pre-defined set of imaginary

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straight lines emanating from the point, assigning a value of 0 to each of these lines that does not pass through an illuminated point, a value of 1 if the closest illuminated point that it passes through is illuminated with the colour of the player, and -1 if it is in the opponent's color and then compares the sum of the values of all the lines to a fixed number, and if the sum is larger or equal the point is a legal move for the player as recited in claim 1. By having the game manager (computer) to check if a move by the player is legal, one of ordinary skill in the art would provide an acknowledgement that a correct or incorrect move has been made.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include to Golad a game manager to verify correct and incorrect movers by a player to provide an acknowledgement that a correct or incorrect move has been made.

### ***Response to Arguments***

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

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In the previous office action regarding the 103 rejection of Blumberg et al. (US 5417425) in view of Othello (Shadow125 Java Applet), the examiner hereby withdraws the rejection.

Applicant's arguments relative to the provisional double patenting of applications 10/031890 and 10/031,942 the examiner has considered all of the applicant's arguments but maintains the rejection for the following reasons. The examiners position that the claimed subject matter for both of the applications uses the same game board and only changes the pattern and the claims in the copending patent applications have not been allowed and that it is not clear what claim limitations will be if those applications are in fact allowed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
APR

  
XUAN M. THAI  
SUPERVISORY PATENT EXAMINER  
7C3700